

REMARKS

Claims 11 to 26 are pending.

In view of the following, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

As to paragraph two (2) of the Office Action, claims 24 to 26 were rejected under 35 U.S.C. § 112, second paragraph, as indefinite for their use of the term “HF/H₂O gas.” The usage of the term “HF/H₂O” is well known to those skilled in the art, especially in view of its description in the present application, including page 8. Since, “[d]efiniteness of claim language must be analyzed, not in a vacuum, but in light of: . . . [t]he claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made,” MPEP § 2173.01, claims 24 to 26 are definite, and it is respectfully requested that the indefiniteness rejections be withdrawn.

As to paragraph five (5), claims 11, 12, 15, 18, 19, 21, and 22 were rejected under 35 U.S.C. § 102(b) as anticipated by Jansen et al., International Pub. No. WO 96/008036.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the prior Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

Claim 11 is to a “method for producing a micromechanical oscillating mirror device,” which includes the feature of “deep etching the first trench using a second anisotropic plasma etching step starting from the bottom of the trench and extending the trench to a predetermined depth of the silicon substrate layer,” “the second anisotropic plasma etching step specifies the depth of the sacrificial layer,” and the feature of “performing an isotropic sacrificial layer etching step starting from the first trench to remove a region of the sacrificial layer below the island region by lateral etching undercutting of the silicon substrate layer, whereby the island region is exposed and made vertically movable.”

Nothing in the Jansen reference identically discloses (or even suggests) the feature of deep etching a first trench using a second anisotropic plasma etching step *starting from the bottom of the trench and extending the trench to a predetermined depth of the silicon substrate layer,*” which the second anisotropic plasma etching step specifies the depth of the sacrificial layer.” Specifically, the Jansen reference does not identically disclose (or even suggest) extending a trench to a predetermined depth of a silicon substrate layer. The Jansen reference also does not identically disclose (or even suggest) that a second anisotropic plasma etching step specifies the depth of a sacrificial layer. In addition, nothing in the Jansen reference identically discloses (or even suggests) performing an isotropic sacrificial layer etching starting from the first trench to remove a region of the sacrificial layer below the island region by lateral etching undercutting of the silicon substrate layer, *whereby the island region is exposed and made vertically movable,* as provided for in the context of the claim.

Accordingly, claim 11 is allowable, as are its dependent claims 12, 15, 18, 19, 21, and 22.

As to paragraph six (6), claims 11, 12, 15, 18, 19, 21, and 22 were rejected under 35 U.S.C. § 102(b) as anticipated by Becker et al., German Patent App. Pub. No. DE 198 47 455 A.

The Becker reference does not identically disclose (or even suggest) the feature of deep etching the first trench using a second anisotropic plasma etching step *starting from the bottom of the trench and extending the trench to a predetermined depth of the silicon substrate layer,*” which “ the second anisotropic plasma etching step specifies the depth of the sacrificial layer.

Accordingly, claim 11 is allowable, as are its dependent claims 12, 15, 18, 19, 21, and 22.

As to paragraph nine (9), claims 13, 14, 16, 17, 20, and 23 to 26 were rejected under 35 U.S.C. § 103(a) as unpatentable over Jansen et al., International Patent App. Pub. No. WO 96/008036, in view of Blanchard, U.S. Patent App. Pub. No. 2002/0066924, and Kleinhenz et al., U.S. Patent No. 5,876,879.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

As explained above, the Jansen reference does not disclose or suggest all of the features of independent claim 11. Since the Blanchard and Kleinhenz references do not cure the critical deficiencies of the primary Jansen reference, claims 13, 14, 16, 17, 20, and 23 to 26, which depend from claim 11, are allowable for the same reasons as claim 11.

In sum, claims 11 to 26 are allowable.



CONCLUSION

In view of the foregoing, it is respectfully submitted that all of the presently pending claims are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,

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